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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 37

CALMAR, INC.,

Petitioner,

—v.—

COOK CHEMICAL COMPANY,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

REPLY BRIEF FOR PETITIONER

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I

The brief for respondent clearly illumines the fundamental error of the courts below, by following the same erroneous path. That fundamental error was the viewing of the issue of the validity of the Scoggin patent in terms of whether the device produced by respondent under it amounted to a commercial innovation, rather than in terms of whether the Scoggin patent disclosed an "invention." But under the statute and the Constitution, the only question is whether the Scoggin patent disclosed an invention: "our patent system is *not* written in these terms [the terms of commercial exploitation and innovation]. The criterion for patenting is the creating of an 'invention.' . . . " Stedman, *The U.S. Patent System and Its Current Problems,*

42 Texas L. Rev. 450, 454 (1964). See 35 U.S.C. §§ 101, 102, 103.

The respondent seeks to conceal this complete reliance on commercial innovation as a substitute for invention, but it shines through its brief. Two striking illustrations may be given. *First,* the brief manages to discuss what the "invention" embraced by the Scoggin patent is supposed to be without ever once quoting from or referring to the claims of Scoggin's patent.— In fact, from a reading of respondent's brief, the well-known man from Mars would not know that there were any such things in the patent system as the patent "claims," and he would be thunderstruck to realize that their time-honored function is to define what the invention is supposed to be: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112. See *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.,* 340 U.S. 147, 149 (1950); *United Carbon Co.* v. *Binney & Smith Co.,* 317 U.S. 228 (1942).

Second, the brief, for understandable reasons, virtually avoids any reference whatsoever to the extensive relevant prior art, which conclusively refutes the presence of any "invention" in the reshuffling of elements embraced in the Scoggin bottle cap patent. Scarcely over a page (Res. Br., pp. 25-26) is spent on all the prior art. But, of course, the prior art has always been the dominant factor in a consideration of whether a patent embraces an invention—or, if put in terms of Section 103 of the Patent Code, whether "the differences between the subject matter sought to be patented *and the prior art* are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

to which said subject matter pertains." (Emphasis supplied.)

The classic approach to the question of invention is illustrated by the leading patent decisions of this Court. The approach followed in these decisions is to set the claims of the patent in suit against the prior art and to arrive at a conclusion whether any advance over the prior art amounting to an "invention" is disclosed in the invention covered by the claims. See *Electric Cable Joint Co.* v. *Brooklyn Edison Co.*, 292 U.S. 69 (1934); *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U.S. 350 (1939); *Marconi Wireless Telegraph Co.* v. *United States*, 320 U.S. 1 (1943); *Jungersen* v. *Ostby & Barton Co.*, 335 U.S. 560 (1949); and *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950). Instead of setting the claims of the Scoggin patent against the prior art, the respondent—while amazingly disclaiming any substantial reliance on the factor of "commercial success" (Res. Br., pp. 35-37)—devotes its brief to a commercial history of the activities of the manufacturers of insecticides, as though what they had done were synonymous with the "prior art." (Res. Br., pp. 3-11; 22-24; 29-35) The discussion boils down to the asserted fact that respondent was the first to mass-market an insecticide "package" which offered a plastic finger-operated liquid dispenser covered by a plastic cap; and to the assertion that in so doing, respondent supposedly overcame various commercial "problems." Even assuming that this was so,[1] the question remains—and it cannot be

[1] The respondent's "success story" omits the all-important final chapter, in any event. As we have developed in our main brief, the next commercial development after the introduction of the Cook bottlecap, followed by the Calmar SS-40, was for Cook to admit the imperfection in the seal in its bottlecap and change it to adopt an external seal of the sort used by Calmar; and later to

answered affirmatively—whether the solution to these commercial problems took the form of an "invention"—which happens to be the only type of solution which the patent laws reward, or constitutionally could reward, with their seventeen-year monopoly.

To return in a little more depth to these two illustrations of the respondent's basic fallacy:

1. *Redefinition of the invention in terms of the commercial device.*—Respondent's brief is most instructive in its definition of what the "invention" disclosed in the Scoggin patent was. As noted above, respondent does not feel limited by the settled rule that the claims of the patent define the invention, since it never bothers to mention the very narrow claims which were finally allowed by the Patent Office, the central one of which we set forth in the margin.[2] Instead, the respondent's definition of the inven-

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adopt Calmar's system of internal seals. (Pet. Br., pp. 8-9) (The internal seals of the Calmar SS-40 were, of course, the real solution to any "shipper-sprayer" problem.)

[2] "In a closure assembly for an open-top container having a perforated cap over said open top thereof mounting a spray unit including a barrel provided with a tubular extension passing coaxially upwardly through the perforation in said cap, a plunger reciprocably carried by the barrel and normally extending therebeyond and a spray head on the upper end of the plunger above said extension, the combination with said spray unit of an annular retainer telescoped over and secured to the extension above said cap and provided with external, circumferentially disposed screw threads and an annular, continuous segment at the upper part of the retainer above said screw threads, and a cup-shaped hold-down member housing the head and holding the plunger depressed at substantially the innermost path of travel thereof within the barrel, said member being provided with internal screw threads complementally engaging said screw threads on the retainer and having an internal, circumferentially extending, continuous shoulder disposed to engage said segment around the entire periphery thereof and thereby present a liquid-tight seal located between the spray head and said threads on the retainer and said

tion is either in purely metaphorical terms or in terms which amount simply to a description of the commercial application of the respondent's sprayer.

Thus, in its metaphorical treatment, the respondent says: "The invention is concisely defined by the Court of Appeals in the summation as 'a completely integrated device' in the nature of 'a container with an integrated sprayer-pump'; the 'novel "marriage" of the sprayer with the insecticide container' constituting a 'unique combination.'" (Res. Br., pp. 22-23) And in other passages, we find the respondent attempting to define the "invention" entirely in terms of the supposed commercial innovation in the Cook product. Thus, in its "Question Presented," the respondent states that: "The patent in issue covers a *shipper-sprayer*, which is a unit capable of being integrated and shipped with a liquid container as a composite package." (Res. Br., p. 2) And respondent relies for a definition of the "invention" on the testimony of its expert witness as to "the device's novel contribution to the industry."[3] (Res. Br., p.

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member respectively, said shoulder being spaced from the lower annular peripheral edge of the member a distance at least slightly less than the distance from that portion of said segment normally engaged by said shoulder, to the proximal upper surface of the cap whereby said lower edge of the member is maintained out of contacting relationship with the cap when the member is on the retainer in a position with said shoulder in tight sealing engagement with the segment." (R. 370)

[3] That description contains a number of elements which are not only not reflected in the patent claims but are not even referred to in the general description of the subject matter set forth in the specification of the Scoggin patent. The Scoggin patent refers to "insecticide" only in referring to a prior art patent; and it does not refer to "automated assembly" at all, or to the sequence of assembly of the gadget. All three of these points, which are central to the expert witness' description quoted at Res. Br., p. 15, and were heavily relied on by the Court of Appeals, relate simply to commercial application, not to anything even remotely claimed as an invention by Scoggin.

15) Remarkably, resort is even had to the respondent's advertising literature to attempt to define the "invention." Respondent says: "Cook's advertising literature stated that the 'sprayer comes completely assembled with a protective plastic cap . . .' and that the product 'manufacturer can begin immediately to package his product with the sealed-in sprayer.' Both the trial court and the Court of Appeals accepted these descriptions of the nature of the invention."[4] (Res. Br., pp. 15-16)

So fundamental is the nature of the wrong tack taken by respondent that we must reiterate once again that the question is not the alleged novelty of Cook's commercial device measured against the background of the commercial operations of the parties to this case, but whether Scoggin invented anything over and above the prior art; or in terms of § 103, whether his patent discloses anything more than an obvious modification of the prior art. In this respect, the history of Scoggin's application in the Patent Office is compelling. When Scoggin first submitted his patent application, his claims (R. 353-55) were almost as sweeping and broad as the descriptions currently essayed in respondent's brief as to what was the "invention" here. In effect, in these first claims, Scoggin did claim the "marriage" of the container cap, plunger, and overcap, which apparently now is said to be the "invention." But even the Patent Office was not prepared to recognize anything of this nature, and Scoggin's claims were rejected as anticipated by the 1938 Lohse patent. (R. 358-59) —Lohse's device was, of course, a "shipper-sprayer," *i.e.*, one in which there was an overcap over the sprayer permitting the entire assembly to be shipped in the bottle. (R. 408) Lohse's device com-

[4] That, of course, was part of their error. See our discussion of the nature of the question presented to this Court in Part II hereof.

bined all the basic elements of the initial Scoggin claims: a depressible plunger mounted in a container cap, a screw-threaded hold-down overcap to depress the plunger during shipment, and a seal over the plunger to prevent the fluid from leaking out of the overcap during shipment.[5] (R. 408-09)

Scoggin at once lowered his sights and began to focus instead (Claims 16, 17, R. 360) on the specific sort of seal he was providing in the bottle cap. Even this was too much for the Examiner in terms of the prior art and he rejected these claims. (R. 362-63) Further efforts were then made to describe the invention in terms of even more narrow details of the specific sort of seal Scoggin was using. (Claims 18-24, R. 363-65) After an interview with the Examiner, these claims in turn were withdrawn, and new claims (Claims 25-28, R. 370-71) of an even more narrow

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[5] One of the basic purposes of Lohse's invention was stated to be "making provision for convenient and safe transportation [of the bottle and sprayer] when filled, or partly filled, with liquid without danger of leakage of the contents." (R. 408) Scoggin himself testified that the Lohse sprayer was "an integrated sprayer." (R. 170)

Lohse's device came before the recent developments in plastics, although its claims and its disclosure are not restricted to any particular material, and in fact some use of plastic (bakelite) was contemplated. (R. 409) It has been clear for over a century that it would not be an invention to redo the Lohse device entirely in plastic. See *Hotchkiss* v. *Greenwood*, 11 How. 248, 266 (1850). And, as we argue in our main brief, it was not invention—or, for that matter, any real change in the combination of elements disclosed by Lohse (Pet. Br., p. 22), to alter, as Scoggin did, the location of the seal shown in Lohse to a position above the threads of the Lohse overcap—a position clearly taught by the Mellon and Livingstone patents.

Respondent claims that the seal shown in Lohse would not prevent leakage. (Res. Br., p. 25) Its record references are simply to testimony that when Scoggin experimented with putting the seal where Lohse put it, his device leaked, for reasons not articulated. Obviously, there is no reason inherent in the Lohse device why there should be leakage in effecting the seal at this point; and in fact Lohse's seal clearly would be and was effective. (R. 288-89, 407, 408)

nature substituted. These amended claims included, by admission of Scoggin's attorney, "limitations which must be in the claims in order to define novelty" over the prior art. (R. 371) Quite obviously because of the practice of the Patent Office in patenting trivial modifications, if they are narrowly stated, these claims were finally allowed.[6] (R. 374)

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[6] The respondent protests the references we have made to the Patent Office's proclivity for issuing invalid patents, and to the procedures of the Patent Office, claiming that they are "logically irrelevant" to consideration of the patent in suit. But it is impossible to understand why a patent of the sort involved here ever issued without some general view of the manifest proclivity of the Patent Office for issuing patents on any trivial device or trivial modification of a device on which there is not the most direct of anticipations. And it is impossible realistically to consider the issues presented by this case apart from this background.

Indeed, the Patent Office seems to view its performance in terms of the number of patents it can turn out. Commissioner of Patents Edward J. Brenner recently indicated with pride that "the percentage of applications allowed in Fiscal 1965 was approximately 68%, as compared with 63% for the preceding year."

Evidently there are production goals or norms or some other sort of stakhanovite system in the Patent Office respecting the production of patents, for the Commissioner said further: "I am pleased to note that our overall average for indicating allowable claims and allowable subject matter in first actions is nearly 50% of the first actions, which is our overall goal in this respect. A large number of our Groups are now meeting their particular goals of indicating allowable claims or subject matter in first actions at a level equivalent to 75% of the ultimate allowance level for their particular group. It is hoped that the other Groups will also be able to meet their particular goals in this regard in the near future."

We do not wish to create the impression that there are no limits in the Office on the issuance of patents. The Commissioner's speech definitely indicates one limitation. "We also anticipate that we will issue approximately 67,000 patents in Fiscal 1966, which represents the approximate limit of the Government Printing Office to print patents." (Address before Patent, Trademark and Copyright Section, ABA, Miami, August 7, 1965, Dep't of Commerce Release, pp. 3, 7).

While the claims allowed in these proliferating patents may be trivial, respondent's brief indicates a technique for enlarging them once the patent issues; simply forget about the allowed claims of the patent and redefine the invention in terms of metaphors and one's advertising circulars.

Of course, once the patent was in suit, and in this Court, respondent proceeds to resurrect a description of the "invention" which is, if anything, only like the original Scoggin claims which the Patent Office found to be obviously anticipated by Lohse. Having chosen to dismiss the claims of the Scoggin patent and the prior art as irrelevant, the respondent is apparently not embarrassed by the fact that all three of its new definitions of the Scoggin "invention" —the definition by respondent's attorneys (Res. Br., p. 2), the definition by respondent's expert witness (Res. Br., p. 15), and the definition by respondent's advertising department (Res. Br., pp. 15-16)—describe in detail the 1938 Lohse sprayer.[7]

2. *Substitution of a history of commercial activities for an examination of the prior art.*—Respondent's new version of patent law does not, as we have noted, end with a substitution of metaphors and commercial advertisements for the patent claims as a definition of the "invention." It is also necessary, in the respondent's amendment of the patent laws by substituting commercial innovation for invention, to find some substitute for the frame of reference conventionally used—the "prior art." This substitute has been found in the commercial history of the insecticide industry. Thus, respondent observes: "For many years insecticide manufacturers had been subject to a pressing need for a sprayer that could be integrated into an insecticide container." (Res. Br., p. 29) Respondent's argument appears to be that since Cook was allegedly the first to solve "this problem," the Scoggin patent, which shows the Cook commercial device, must contain an "invention." (See Res. Br., p. 35)

[7] Lohse's sprayer was, in fact, capable of automatic assembly and was put together as a "package" before insertion in the bottle of liquid for shipment. (R. 288-89)

While there might be something to this if the issue were whether the Cook device were a "commercial innovation," this analysis is not particularly helpful in determining whether the claims of the Scoggin patent set forth an "invention."

If the various insecticide manufacturers had been wondering for a long time how they would solve their so-called "problem" of finding an appropriate means of merchandising their product with a sprayer, and one of them had found an old patent which completely disclosed every detail of a solution for the problem, it would have been a good thing for the manufacturer in question and for the rest of the industry. But finding the old patent would not have been a new invention and no one would have claimed that the person who found the old patent and commenced application of it in the liquid insecticide industry should be rewarded with a new patent.[8] That would completely defeat one of the basic purposes of the patent system: the purpose of encouraging disclosure of inventions which, after the statutory monopoly period, can be freely used and applied by anybody.—But this is virtually what happened here, since the old expired Lohse patent in fact did disclose all the essential details of an integrated shipper-sprayer with a depressible plunger, and a hold-down cap effecting a seal over the plunger.

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[8] Perhaps we should not be so sure. At Res. Br. p. 16, respondent asserts that there is no basis for suggesting: "that the Scoggin invention is (a) in the provision of the space or gap, (b) in any special type of seal, (c) in rearrangement or reshuffling of component parts or (d) in any other minute detail as contended by petitioners." This astounding statement leads to the conclusion that respondent confidently expects, on the basis of the decisions below, to assert its patent against anyone who uses, on a conventional sprayer, a cap having a gasket or any other sealing means wherever located. Thus it may be that the respondent thinks that it has at least patented the Lohse device a second time.

Likewise, if someone proceeded to solve "the problem" supposedly bedeviling the insecticide manufacturers by making a simple combination of ideas shown in two old patents, with the various combined elements performing no new functions in the combination, there would likewise be a solution to the problem but there would be no invention, and no new patent should issue. As the Court put it in the *Supermarket Equipment* case, it might be a "good idea," but it would not be an invention. 340 U.S., at 153. At the very most, this is what happened here.

In fact, in one of its rare references to the relation of the prior art to Scoggin's patent, the respondent on this point is constrained to argue that a long line of cases of this Court dealing with combination patents—which demand, a "new or different function or operation" for the combined elements "than that theretofore performed or produced by them" (*Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545, 549 (1938)), or that "the whole in some way exceeds the sum of its parts," (*Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950)), or that the "old elements" must "perform [an] . . . additional or different function in the combination that they perform out of it" (*Ibid.*)—"should be read as meaning" something quite different from what they say. (Res. Br., pp. 27-28)

Respondent says that the opinions *really* mean only that the combination is patentable "if the joint operation of the old elements in the combination performs or produces a new or different function or operation than was performed by *any* of the parts separately." (Res. Br., pp. 27-28; emphasis supplied) The opinions have not been guilty of any such nonsense. Of course, any combination of two old elements—unless one of the elements is superfluous or

purely decorative in the combination—performs an additional function to that performed by *either* of the two separate parts.

* * * * *

Clearly adverse consequences would attend the expanded scope of what would be relevant and consequential if the classic approach of comparison of the prior art with the claims of the patent in suit is abandoned, as is the thrust of respondent's brief. Matters apart from the prior art —which matters are so extensively relied on by the respondent—are not known to the Patent Office when it issues a patent. To the extent that they become relevant, the only result can be the introduction of an even wider gap between what the Patent Office considers patentable and what the courts consider patentable. Moreover, as we set forth in our main brief, the result of taking considerations of this sort into account is to make it increasingly more difficult to forecast the outcome of patent litigation. Given the Patent Office's proclivity for the issuance of invalid patents, the results of this cannot help being adverse to the public interest. (Pet. Br., pp. 32-33)

Illustrating this broadened scope of relevance, the fact that Calmar's technicians tried various alternative means to prevent leakage out of the pump itself—which means that they were pursuing the tack which eventually led to the superior internal seals of the Calmar SS-40—somehow becomes relevant to the question whether the Scoggin device with its inferior external seal constituted an invention. (See Res. Br., pp. 32-33) But, once again, the question is not whether there was a problem that the insecticide manufacturers were attempting to solve. The only question is whether Scoggin's "solution" to it amounted to an invention.

Also, under this expanded concept of relevance, the relative financial condition of the patentee and the alleged infringer apparently becomes relevant; at least to the extent seemingly of justifying references to it in the respondent's brief. (Res. Br., pp. 3-4) Presumably by an expansion of this theory, the acquisition of The Drackett Company by Bristol-Myers Company in July 1965 becomes of relevance to the validity of the Scoggin patent, and, indeed, apparently so does the market structure in the toothpaste and detergent industries. (Res. Br., p. 4) It is a pity that materials of this sort occupy space in respondent's brief which might with more relevance have been devoted to an examination of the prior art.

II

The respondent, finally, even resorts to the tired proposition that the question of invention here is a question of fact and that this Court should accordingly defer to the conclusions of the lower courts.[9] (Res. Br., p. 32) Historically, the question of whether a patent is void for want of invention has been so far from being considered one of pure "fact" by this Court that there are Nineteenth Century cases which hold that the question of invention is so fundamental that it might be raised *sua sponte* by the court. See *Brown* v. *Piper*, 91 U.S. 44 (1875); *Slawson* v. *Grand Street, P. P. & F. R. Co.*, 107 U.S. 649 (1883). And the most recent opinion of this Court on the subject expressly

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[9] This argument is a favorite of the various Patent Bar Associations and other parties that have filed *amicus curiae* briefs in No. 11, *Graham* v. *John Deere Co.* See Brief Amicus Curiae of Professor Goldstein, pp. 6, 7-8, 11; Brief Amicus Curiae of Illinois State Bar Ass'n, pp. 6, 7, 9; Brief Amicus Curiae of New York Patent Law Ass'n, pp. 9-10.

rejects the contention that the question of invention is one of fact, on which—as it was argued there—the concurrence of the two lower courts should be conclusive. See *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 153-54 (1950); *id.*, at 156 (concurring opinion).[10] *Cf. Dalehite* v. *United States*, 346 U.S. 15, 24 (1953); *United States* v. *Parke, Davis & Co.*, 362 U.S. 29, 44-45 (1960); *United States* v. *Mississippi Valley Generating Co.*, 364 U.S. 520, 525-26 (1961). Respondent cites nothing in the text or legislative history of the 1952 codification of the patent laws that would indicate any change on this point, and there is none.

Indeed, although the respondent and the courts below use certain of the language of this Court's decisions, it is clear that the respondent's approach—which is identical to that of the courts below—is one involving the application of an entirely misconceived standard or approach to the question of patentability. That approach is to abandon the classic test of comparison of the claims of the patent in suit with the prior art, in favor of an examination of the matter purely in terms of commercial innovation and commercial success. As we have developed in our main brief, this is a plain error of law, which has the effect of diverting attention from the only question in issue—whether a patentable invention was made—and focusing it instead

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[10] This Court's last action on the merits in a case of patent validity —its *per curiam* reversal in *Crest Specialty* v. *Trager*, 341 U.S. 912 (1951)—is instructive as to the point that invention is not, in essence, a question of fact but one of law. In the *Trager* case, the lower courts undertook to find that it was "beyond the skill of a mechanic and require[d] exercise of inventive genius" to devise a child's feeding dish having on its rim a figure of a pig which an adult could pretend to "feed" so as to coax the child into eating. *Trager* v. *Crest Specialty*, 184 F.2d 577, 578 (7th Cir. 1950). Despite this "finding of fact" this Court summarily reversed the judgment.

upon questions which are irrelevant to the issue of whether the conditions exist for the lawful existence of the patent monopoly. (Pet. Br., pp. 28-31)

CONCLUSION

For the reasons stated in our main brief and in this reply brief, the judgment of the Court of Appeals should be reversed, and the case remanded to the District Court with instructions to grant petitioner's prayer for a declaratory judgment that the Scoggin patent is not valid, and to dismiss respondent's counterclaims.

Respectfully submitted,

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